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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,372	07/11/2003	Mark G. Gilreath	P-4438-US	2855

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EXAMINER	
KISH, JAMES M	

ART UNIT	PAPER NUMBER
3737	

MAIL DATE	DELIVERY MODE
04/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/617,372	GILREATH ET AL.	
	Examiner	Art Unit	
	JAMES KISH	3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7-11,18-20 and 23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,7-11,18-20 and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 5, 2009 has been entered.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claims 1-4, 7-11, 18-20 and 23 are objected to because of the following informalities:

Claim 1 is objected to because “the image sensor” at line 9 lacks antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidaka et al. (US Patent No. 6,095,970) – herein referred to as Hidaka – in view of Kislev et al. (WO 00/76391) – herein referred to as Kislev. Hidaka discloses an endoscope including an insertion tube which is inserted into a human body (*see* Abstract). The second embodiment of Hidaka -- found at column 6, line 1 through column 7, line 49 and illustrated in Figures 5 and 6 -- describes a unit body accommodating an object optical system (i.e., lenses) and a CCD (i.e., an imager). The object optical system is covered by a view window 211 (which is dome-shaped)

disposed at the front end of the unit body. This embodiment also has a first and second channel **238** and **239** that line up to allow a medical instrument to pass through to the exit opening into the patient. An exemplary medical instrument is forceps. However, this second embodiment fails to teach an illumination source. Several of the other embodiments of Hidaka teach an illumination source being fed through the channel which in the second embodiment is used for the medical instrument. However, this would not allow a medical instrument to be used in a procedure while illumination is provided, thereby defeating the second embodiment all together. Kislev teaches an optical system for illuminating and viewing a target in which an illumination element and a receiving element are disposed behind a single optical window (*see* Abstract). Page 1, lines 18-19 of Kislev teaches, "examples of such optical systems can be found in diagnostic apparatuses such as endoscope devices." It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an illuminating element behind the same optical window as the imager, as taught by Kislev, in the endoscope of Hidaka, because these optical systems (i.e., a single optical window) have advantageous (page 2, line 1 of Kislev). In diagnostic apparatuses, especially those meant to be inserted into body orifices, having a single optical window is advisable for hygienic and practical considerations (page 2, lines 8-10 of Kislev). Furthermore, it would allow a medical instrument, such as forceps, to be used in the second embodiment of Hidaka while illumination and imaging is taking place, thereby allowing the surgeon to view the area which is being operated on by the forceps.

Regarding claim 2, Hidaka teaches a manipulator is connected to a controller unit at the non-inserted end to control the medical instrument (column 3, lines 51-55).

Regarding claim 3, Hidaka teaches that the tool is made of plastic such as tetrafluoroethylene or Derlin (column 7, lines 42-43).

Regarding claim 4, Hidaka's example of a medical instrument is forceps (column 7, line 3).

Regarding claim 11, Hidaka teaches a first and second channel **238** and **239** that line up to allow a medical instrument to pass through to the exit opening into the patient.

Claims 7-10, 18-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidaka in view of Kislev as applied to claim 1 above, and further in view of Ueda et al. (US Patent No. 5,681,260) – herein referred to as Ueda. Hidaka in combination with Kislev is previously described. However, neither of these two references explicitly state that an LED is used or teach wirelessly transmitting data. Ueda discloses a guiding apparatus for guiding an insertable body within an inspected object. Ueda, similarly to Hidaka, teaches an endoscope with a functional unit. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a wireless transmission unit, as taught by Ueda, in the device of Hidaka as a functional equivalent to providing a hardwire link. Ueda explicitly states, "Said control apparatus comprises a transmitting and receiving part transmitting and receiving signals with or without wires (column 18, lines 27-38; emphasis added).

Regarding claims 7 and 23, one embodiment Ueda teaches an LED is utilized as the illumination device powered by a battery (*see* column 18, lines 9-27 and Figure 27).

Regarding claims 8-10, Ueda teaches that information and instruction can be sent wirelessly between the device and the controlling apparatus (column 18, lines 27-38).

Regarding claims 18-20, Ueda teaches that information can be passed to and from the device via a transmitter and a receiver (column 18, lines 18-20). Within the process circuit, there is a memory unit, as described in column 24, lines 35-47. The system illustrated in Figure 1(a) comprises monitor **7**.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES KISH whose telephone number is (571)272-5554. The examiner can normally be reached on 8:30 - 5:00 ~ Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRIAN CASLER/
Supervisory Patent Examiner, Art Unit 3737

JMK